

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 27-Apr-05
 TO: EXAMINER GRIER, LAURA
 FROM: Jefferson, Henry
 PARALEGAL SPECIALIST

APPL. S.N.: 09/195,129
 ART UNIT: 2644

Case Drop-Off Location
 RETURN THIS MEMO TO: JEF-2D68

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 01-Sep-04

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶ 14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):
- ☐ The TD fee of has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
 - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶ 14.26 & 14.26.01).
 - ☐ The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
 - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since “the disclaimer must be for a terminal portion of the term of the entire patent to be granted” (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).
 - ☐ The person who signed the T.D.:
 - ☐ is not an attorney “of record” (see ¶¶ 14.29 and 14.29.01).
 - ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
 - ☐ is not recognized as an officer of the assignee (see ¶¶ 14.29 & possible 14.29.02).
 - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
 - ☐ The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).
 - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
 - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶ 14.26, 14.27.02 or 14.26.05).
 - ☐ The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.26.03).
 - ☐ Other:
 - ☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: _____ Date: _____

Log Date: _____



Express Mail No. EV 534 876 055 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Zhou, et al. Confirmation No.: 3991
Serial No.: 09/195,129 Art Unit: 2644
Filed: November 18, 1998 Examiner: Laura A. Grier
For: *Apparatus and Method for Improved PC Audio Quality* Attorney Docket No.: 60976-0005
Date: September 1, 2004

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, **Oak Technology, Inc.**, the assignee of the entire 100% right, title and interest in and to the above identified application by virtue of an assignment which was recorded on **February 1, 1999** at reel **9739** frame **0840**.

Petitioner hereby disclaims the terminal part of any patent granted on the above identified application which would extend beyond the expiration date of U.S. Patent No. **6,163,789** which issued on **December 19, 2000**, and hereby agrees that any patent so granted on the above identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. **6,163,789**.

Petitioner further agrees that this agreement is to run with any patent granted on the above identified application and is to be binding upon the grantee, its successors, and assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of U.S. Patent No. **6,163,789** in the event that said patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its full statutory term, except for the separation of legal title stated above.

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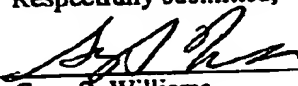
Petitioner hereby confirms that he has reviewed the assignment and, to the best of his knowledge and belief, title is in the assignee seeking to take action in this matter and that he is empowered to act on behalf of **Oak Technology, Inc.**

The undersigned is empowered to act on behalf of and as a representative of **Oak Technology, Inc.** The undersigned is the attorney of record representing the assignee of the applicant and has no other interest or business interest in the assignee, **Oak Technology, Inc.**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Date: September 1, 2004



Gary S. Williams
MORGAN, LEWIS & BOCKIUS LLP
3300 Hillview Avenue
Palo Alto, California 94304
(650) 493-4935

31,066
(Reg. No.)



Express Mail No. EV 534 876 055 US

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor of: Zhou, et al.

Confirmation No.: 3991

Serial No.: 09/195,129

Art Unit: 2644

Filed: November 18, 1998

Examiner: Laura A. Grier

For: *Apparatus and Method for Improved PC
Audio Quality*

Attorney Docket No.: 60976-0005

Date: September 1, 2004

TERMINAL DISCLAIMER

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P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The fee for processing the attached Terminal Disclaimer is believed to be \$110.00.
Please charge the required fee to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (60976-0005). A copy of this sheet is attached for accounting purposes.

Respectfully submitted,

Date: September 1, 2004


Gary S. Williams

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